

REMARKS

Claims 50 to 53 are added, and therefore claims 1, 2, and 21 to 35, 41, 42, 44 to 48, and 50 to 53 are currently pending and being considered in the present application (since claims 3 to 20 were previously withdrawn in response to a restriction requirement and later canceled).

In view of the following, it is respectfully submitted that the presently pending and considered claims are allowable, and reconsideration is respectfully requested.

Claims 1, 2, 21 to 33, 41, 42, 45 and 46 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5, 839,349 ("Volz") in view of German Published Application No. 100 18 143 ("Massler I") and the Background Information (at page 2, lines 20 to 34).

To reject a claim under 35 U.S.C. § 103(a), the Office bears the initial burden of presenting a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish *prima facie* obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Also, as clearly indicated by the Supreme Court in *KSR*, it is "important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements" in the manner claimed. *See KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727 (2007). In this regard, the Supreme Court further noted that "rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *Id.*, at 1396. Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Claim 1 includes the features in which the rotational motion of a drive is transmitted via the at least one shaft to the at least one piston, in which a section of the metal housing

abuts the at least one piston next to the at least one shaft and guide the movement of the at least one piston.

Any review of Massler and Volz, whether taken alone or combined, readily confirms that the applied references do not disclose or even suggest the above-discussed feature of claim 1. In fact, the present Office Action does not even assert that this feature is disclosed or suggested in any of the references. The pump of Volz, for example, supposedly includes a “a metal piston (2, 3) and an elastomeric sealing element (Shown in Fig on Pistons 2, 3).” (See Office Action at pg. 2). However, as can clearly be seen in the Fig of Volz, the housing (1) of Volz does not abut the piston (2, 3) next to a shaft (6) and guide the pistons’ movement as provided for in the context of the presently claimed subject matter.

Accordingly, it is respectfully submitted that the Volz, Massler and the Background Information do not render unpatentable claim 1, as presented, for at least the above reasons, so that claim 1 is allowable, as are its dependent claims.

In view of all of the foregoing, withdrawal of the rejections is respectfully requested.

Claims 34, 35, 47 and 48 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Volz in view of Massler I as applied to claims 1 and 45 above, and further in view of U.S. Patent No. 5, 577,896 (“Harada”).

Claims 34, 35, 47 and 48 depend from claim 1, and they are therefore allowable for the same reasons, since the Harada reference does not cure – and is not asserted to cure -- the deficiencies of Volz and Massler as to claim 1, as presented. Withdrawal of the obviousness rejections is therefore respectfully requested.

As further regards all of the obviousness rejections, any Official Notice is respectfully traversed to the extent that it is maintained and it is requested that the Examiner provide specific evidence to establish those assertions and/or contentions that may be supported by the Official Notices under 37 C.F.R. § 1.104(d)(2) or otherwise. In particular, it is respectfully requested that the Examiner provide an affidavit and/or that the Examiner provide published information concerning these assertions. This is because the § 103 rejections are apparently being based on assertions that draw on facts within the personal knowledge of the Examiner, since no support was provided for these otherwise conclusory and unsupported assertions. (See also MPEP § 2144.03).

Accordingly, claims 1, 2, and 21 to 35, 41, 42 and 44 to 48 are allowable.

New claims 50 to 53 do not add any new subject matter and are supported by the present application, including the specification. Claims 50 to 53 depend from claim 1, and they are therefore allowable for the same reasons, and for the further reasons that they include combinations of features that are not disclosed or suggested by the applied references.

Accordingly, claims 1, 2, and 21 to 35, 41, 42, 44 to 48, and 50 to 53 are allowable.

CONCLUSION

It is therefore respectfully submitted that all of the presently pending and considered claims are allowable. It is therefore respectfully requested that the rejections (and any objections) be withdrawn, since all issues raised have been addressed and obviated. An early and favorable action on the merits is therefore respectfully requested.

Dated: _____

5/4/2010

Respectfully submitted,

By: _____

Gerard A. Messina
(Reg. No. 35,952)

KENYON & KENYON LLP
One Broadway
New York, NY 10004
Telephone: (212) 425-7200
Facsimile: (212) 425-5288

CUSTOMER NO. 26646

1940602